

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF
THE TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Merion Publications, Inc.

Serial Nos. 75/629,629; 75/630,793 and 75/854,084

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Before Hanak, Hohein and Hairston, Administrative Trademark
Judges.

Opinion by Hairston, Administrative Trademark Judge:

Merion Publications has filed applications to register
the marks ADVANCE FOR PROVIDERS OF POST ACUTE CARE;¹ ADVANCE
FOR NURSES, SERVING THE GREATER PHILADELPHIA/TRI-STATE

¹ Application Serial No. 75/629,629, filed January 29, 1999, which
asserts first use and first use in commerce as early as June 25, 1998.

METRO AREA;² and ADVANCE FOR NURSES SERVING THE CAROLINAS AND GEORGIA METRO AREAS,³ each for a "magazine featuring the allied health professions."

In response to the Trademark Examining Attorney's requirement to disclaim the phrases "PROVIDERS OF POST ACUTE CARE," "NURSES, SERVING THE GREATER PHILADELPHIA/TRI-STATE METRO AREA," and "NURSES SERVING THE CAROLINAS AND GEORGIA METRO AREAS" on the ground of mere descriptiveness, applicant amended the applications to seek registration under Section 2(f) of the Act, in part, as to the phrases. Because the Examining Attorney was not persuaded by applicant's argument and evidence in support of the Section 2(f) claims, he issued a final requirement in each application that the phrase at issue be disclaimed apart from the mark as shown, and finally refused to register each mark absent compliance with the disclaimer requirement. Applicant and the Examining Attorney filed briefs and applicant filed a request that the appeals for

² Application Serial No. 75/630,793, filed January 22, 1999, which alleges a bona fide intention to use the mark in commerce. We note that the mark in the drawing includes a comma (,) between "ADVANCE" and "SERVING", whereas the mark as displayed on the specimens does not. Also, it appears from the record that applicant has begun use of this mark although it has not filed an amendment to allege use.

³ Application Serial No. 75/854,084, filed November 19, 1999, which asserts first use and first use in commerce as early as September 20, 1999.

the three applications be consolidated for purposes of oral hearing. The Board approved this request on May 28, 2002 and an oral hearing was held on June 25, 2002. In view thereof, and inasmuch as the three applications involve similar issues and records, this opinion is issued for all three applications.

At the outset, we note that inasmuch as applicant has amended each of its applications to seek registration under Section 2(f), in part, the question of whether any of the phrases at issue are inherently distinctive is not before us. Rather, the sole issue on appeal is the sufficiency of applicant's evidence under Section 2(f) as to the phrases "PROVIDERS OF POST ACUTE CARE"; "NURSES, SERVING THE GREATER PHILADELPHIA/TRI-STATE METRO AREA"; and "NURSES SERVING THE CAROLINA AND GEORGIA METRO AREAS."

In each application, applicant bases its Section 2(f) claim on ownership of prior registrations of the "same mark" and the declaration of Jaci L. Nicely, its director of Human Resources. It is applicant's position that its prior registrations and/or its evidence of use as set forth in the declarations are sufficient to establish that the phrases have acquired distinctiveness. If there is any doubt on the issue, applicant argues that it must be resolved in its favor.

At the outset, we note that it is well settled that the burden of proving that a mark has acquired distinctiveness is on the applicant, and the more descriptive the mark, the greater the evidence needed to establish acquired distinctiveness. See *Yamaha International Corp. v. Hoshino Gakki Co., Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001 (Fed. Cir. 1988). This is also the case where an applicant seeks to prove that a portion of a mark, rather than the mark in its entirety, has acquired distinctiveness.

We consider first whether applicant may base its Section 2(f) claims on its ownership of prior registrations for the "same mark." Relying on Trademark Rule 2.41(b) applicant argues that each of the phrases at issue - "PROVIDERS OF POST ACUTE CARE"; "NURSES, SERVING THE GREATER PHILADELPHIA/TRI-STATE METRO AREA"; and "NURSES SERVING THE CAROLINAS AND THE GEORGIA METRO AREAS" - "is for all intents and purposes, the same as [the] analogous professional designations in [applicant's] sixteen [prior]

'ADVANCE FOR' registrations." (Brief, p. 13).⁴ Thus, applicant argues that each of its applied-for marks is "the same" as its sixteen previously registered ADVANCE marks.⁵

Section 7(b) of the Trademark Act provides that a registration on the Principal Register "shall be prima facie evidence of the validity of the registration, registrant's ownership of the mark and of registrant's exclusive right to use the mark in commerce in connection with the goods or services identified in the certificate." See also *In re Electro Products Laboratories, Inc.*, 156 USPQ 54 (TTAB 1967). Thus, Section 7(b) creates the basis for permitting reliance on an existing registration, under certain circumstances, to support a claim that distinctiveness has been transferred to a mark which is essentially the same as the registered mark. Further,

⁴ The sixteen marks on which applicant is relying are: ADVANCE FOR NURSE PRACTITIONERS; ADVANCE FOR PHYSICIAN ASSISTANTS; ADVANCE FOR PHYSICAL THERAPISTS & PT ASSISTANTS; ADVANCE FOR OCCUPATIONAL THERAPY PRACTITIONERS; ADVANCE FOR RESPIRATORY CARE PRACTITIONERS; ADVANCE FOR SPEECH-LANGUAGE PATHOLOGISTS & AUDIOLOGISTS; ADVANCE FOR ADMINISTRATORS OF THE LABORATORY; ADVANCE FOR HEALTH INFORMATION PROFESSIONALS; ADVANCE FOR RADIOLOGIC SCIENCE PROFESSIONALS; ADVANCE FOR ADMINISTRATORS IN RADIOLOGY & RADIATION ONCOLOGY; ADVANCE FOR DIRECTORS IN REHABILITATION; ADVANCE FOR MANAGERS OF RESPIRATORY CARE; ADVANCE FOR MEDICAL LABORATORY PROFESSIONALS; ADVANCE FOR OCCUPATIONAL THERAPISTS; ADVANCE FOR PHYSICAL THERAPISTS; and ADVANCE FOR AUDIOLOGISTS. Each of the marks contains a Section 2(f) claim, in part. In certain of the marks the Section 2(f) claim is to the wording "FOR" in addition to the professional designation, whereas in others the Section 2(f) claim is to the professional designation only.

⁵ Although applicant characterizes its marks as "ADVANCE FOR" marks, it appears from the specimens of record that the "family" portion of applicant's marks is the single word "ADVANCE," not the phrase "ADVANCE FOR." Thus, we have used "ADVANCE" and not "ADVANCE FOR" in referring to applicant's "family" of marks.

Trademark Rule 2.41(b) provides that, in appropriate cases, "ownership of one or more prior registrations on the Principal Register . . . of the same mark may be accepted as prima facie evidence of distinctiveness."

Thus, the question to be resolved in cases such as these is whether the applied-for mark is "the same" as the applicant's existing registered mark for purposes of Rule 2.41(b). In these cases, applicant is essentially seeking to "tack" the use of its sixteen registered marks to its use of the three applied-for marks for purposes of transferring distinctiveness to the new marks. See, for example, *In re Flex-O-Glass, Inc.*, 194 USPQ 203 (TTAB 1977). Thus, the analysis used to determine whether any of applicant's applied-for marks is the "same mark" as any of its previously registered marks, for purposes of that rule, is similar to the analysis used in "tacking" cases to determine whether a party may rely, for purposes of establishing priority, on its prior use of a mark which is not identical to its present mark. In this situation, the issue is whether either of the applied-for marks and the previous marks are "legal equivalents." See *Van Dyne-Crotty, Inc. v. Wear Guard Corp.*, 926 F.2d 1156, 17 USPQ2d 1866 (Fed. Cir. 1991) and *Institut National Des*

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Appellations d'Origine v. Brown-Forman Corp., 47 USPQ2d 1875 (TTAB 1998).

To meet the legal equivalents test, the marks must be indistinguishable from one another or create the same, continuing commercial impression such that the consumer would consider both as the same mark. See *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001); and *Compania Insular Tabacalera, S.A. v. Camacho Cigars, Inc.*, 167 USPQ 299 (TTAB 1970). A minor difference in the marks such as mere pluralization or an inconsequential modification or modernization of the later mark will not preclude application of the rule. See *In re Loew's Theatres, Inc.*, 223 USPQ 513 (TTAB 1984), *aff'd*, 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985) and *In re Flex-O-Glass, Inc.*, *supra*. At the same time, however, it is clear that the "legal equivalents" standard is considerably higher than the standard for "likelihood of confusion." Thus the fact that two marks may be confusingly similar does not necessarily mean that they are legal equivalents. *Van Dyne-Crotty, Inc. v. Wear-Guard Corp.*, *supra*, and *Pro-Cuts v. Schilz-Price Enterprises Inc.*, 27 USPQ2d 1224 (TTAB 1993).

In these cases, we are not convinced that any of applicant's applied-for marks creates "the same" commercial

impression as the marks in its sixteen existing registrations simply because they consist of ADVANCE and what applicant considers "analogous" professional designations. While the applied-for marks and the existing registered marks are perhaps similar in that they consist of ADVANCE and professional designations in the health care field, the marks are certainly not indistinguishable. To use just one example, applicant's existing registered mark ADVANCE FOR MANAGERS OF RESPIRATORY CARE does not convey the same meaning or commercial impression as its applied-for mark ADVANCE FOR PROVIDERS OF POST ACUTE CARE. The professional designations in these marks are not interchangeable and their use results in more than a minor difference in the marks.

Applicant's own evidence reinforces the perception that the professional designations that it uses have separate and distinct meanings and commercial impressions. As can be seen from the printout at applicant's website, it is clear that the various titles are used to identify different magazines and are directed to distinct audiences in the health care field. Thus, applicant itself promotes the different connotations of the marks to its subscribers.

Further, as to applicant's particular marks ADVANCE FOR NURSES, SERVING THE GREATER PHILADELPHIA/TRI-STATE AREA

and ADVANCE FOR NURSES SERVING THE CAROLINAS AND GEORGIA METRO AREAS, we are not persuaded that they are "the same" as applicant's prior registered mark ADVANCE FOR NURSE PRACTITIONERS. While there is no question that a nurse practitioner is a type of nurse, it is nonetheless the case that a nurse practitioner is a nurse with advanced education and experience in a specialized area of nursing practice. In this regard, we judicially notice the following definitions of "nurse practitioner":

nurse practitioner(NP): a registered nurse who has advanced education in nursing and clinical experience in a specialized area of nursing practice. NP's are certified by passing an examination administered by a professional organization such as the American Nurses' Credentialing Center (ANCC).
Mosby's Medical, Nursing & Allied Health Dictionary (5th ed. 1998); and

nurse practitioner: a registered nurse with at least a master's degree in nursing and advanced education in the primary care of particular groups of clients; capable of independent practice in a variety of settings.
Stedman's Medical Dictionary (27th ed. 2000).

In other words, a nurse practitioner is much more than a nurse, and the professional designations "nurse" and "nurse practitioner" have different meanings and commercial impressions.

These cases are readily distinguishable from *In re Dial-A-Mattress Operating Corp.*, supra, where the applicant

was allowed to tack its use of the registered mark "(212)M-A-T-T-R-E-S to its use of "1-888-M-A-T-T-R-E-S-S for purposes of transferring acquired distinctiveness. The marks were considered the same or legal equivalents because the differences therein were immaterial. In the present case, the differences between applicant's applied-for marks and its existing registered marks are not insignificant.

In view of the foregoing, we find that none of applicant's sixteen registered marks is the same as or the legal equivalent of applicant's applied-for marks and, in particular, NURSE and NURSE PRACTITIONER are not the same or legal equivalents. Thus, applicant may not rely on any of its existing registered marks as the basis for establishing its Section 2(f) claims.

Additionally, to the extent that it is also applicant's position that each of the phrases at issue has acquired distinctiveness on the basis of applicant's ownership of a "family" of ADVANCE marks, this position is untenable. Whether applicant owns a family of "ADVANCE" marks or whether ADVANCE is a distinctive component of applicant's composite marks has no bearing on the question of whether the phrases at issue, which are not part of the so-called family name, should be disclaimed or have acquired distinctiveness. It is clear that an

unregistrable component of an otherwise registrable mark must, in the absence of a 2(f) showing, be disclaimed. See Section 6 of the Trademark Act.

Lastly, we turn to the declarations of Jaci L. Nicely, applicant's Director of Human Resources. In the declarations, Ms. Nicely has set forth information concerning the circulation, advertising and promotion, and the web site "hits" for applicant's magazines ADVANCE FOR PROVIDERS OF POST ACUTE CARE, ADVANCE FOR NURSES, SERVING THE GREATER PHILADELPHIA/TRI-STATE AREA and ADVANCE FOR NURSES SERVING THE CAROLINAS AND GEORGIA METRO AREAS. The problem with this evidence is that it relates to applicant's composite marks, and not the particular phrases which applicant claims have acquired distinctiveness. Thus, the declarations are not probative of whether the phrases at issue, as opposed to the composite marks, have become distinctive. Evidence of acquired distinctiveness must relate to the specific mark for which registration is sought. See *In re K-T Zoe Furniture, Inc.*, 16 F.3d 398, 29 USPQ2d 1787, 1789 (Fed. Cir. 1994). [Where the applicant sought to register "THE SOFA & CHAIR COMPANY" in a stylized script, the Examining Attorney's requirement to disclaim the phrase "THE SOFA & CHAIR COMPANY" apart from the mark was upheld in the absence of a showing that the phrase had

acquired distinctiveness]. Thus, where as here, the applicant claims distinctiveness as to a portion of a mark, the evidence of acquired distinctiveness must relate to that portion. In this case, there is no evidence that subscribers to applicant's magazines and/or those who visit its web site recognize the phrases rather than the composite marks as source-indicators. Moreover, there is no evidence that applicant, in its advertising and promotional materials, emphasizes the phrases at issue rather than its composite marks.

In view of the foregoing, we find that applicant's evidence does not establish that the phrases PROVIDERS OF POST ACUTE CARE; NURSES, SERVING THE GREATER PHILADELPHIA/TRI-STATE METRO AREAS; and NURSES SERVING THE CAROLINAS AND THE GEORGIA METRO AREAS have acquired distinctiveness for applicant's magazines. Of course, we recognize that applicant is the owner of sixteen existing registrations for marks, which include claims of acquired distinctiveness as to portions, which include professional designations. However, as is often stated, each case must be decided on its own set of facts. In re Nett Designs, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001). We are not privy to the files of those registrations and the evidence of acquired distinctiveness submitted therein.

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Decision: In each application the requirement for a disclaimer and the refusal to register in the absence of a disclaimer is affirmed. Nonetheless, this decision will be set aside and applicant's marks published for opposition if applicant, no later than thirty days from the mailing date hereof, submits appropriate disclaimers of PROVIDERS OF POST ACUTE CARE; NURSES, SERVING THE GREATER PHILADELPHIA/TRI-STATE METRO AREA; and NURSES SERVING THE CAROLINAS AND GEORGIA METRO AREAS.